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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WENDELL W. ANTHONY,
JUNDAR HUANG, TRUC NGUYEN,
ASHWIN DOSHI, LESLIE MOSS,
MICHAEL WILLIAMS, DAVID THOMPSON,
HOCK LAW, DONALD EICHENSEER,
STEPHEN EDWARD SAUSSY,
KHANH DO, and BINH LUONG

Appeal 2008-2543
Application 09/077,456
Technology Center 3600

Decided:¹ April 14, 2009

Before JAMES D. THOMAS, LEE E. BARRETT, and
LANCE LEONARD BARRY, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appeal 2008-2543
Application 09/077,456

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1, 4-30, and 33-55. Claims 2, 3, 31, and 32 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part and enter a new ground of rejection.

STATEMENT OF THE CASE

Prior appeal

In a previous decision in Appeal 2002-1880, entered September 8, 2004, the Board affirmed rejections of claims 1-55 over the same reference applied in this appeal. The claims were amended and claims 2, 3, 31, and 32 were canceled. The Examiner maintains the same rejections under 35 U.S.C. § 102 and § 103 as to the pending claims.

Appellants' invention

The invention relates to a system and method for providing remote banking services, such as home banking, in a banking system having an automated teller machine (ATM) wherein the user interface on the screen of the remote terminal is substantially identical to the user interface on the screen of the ATM.

Claims

Claim 1 is reproduced below.

1. A method for providing remote access to financial services comprising the steps of:
 - a) providing at least one business host;
 - b) selectively electronically linking a server to the business host;
 - c) selectively electronically linking at least one automated teller machine (ATM) and at least one home banking terminal to the server; and
 - d) based on the electronic linking, displaying a first user interface on a screen of the ATM and displaying a second user interface on a screen of the home banking terminal, wherein the first user interface and the second user interface are substantially the same.

The reference

Moss	US 5,485,370	Jan. 16, 1996
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The rejections

Claims 1, 6-22, 24-30, 33-37, 40-51, and 53-55 stand rejected under 35 U.S.C. § 102(e) as anticipated by Moss.

Claims 4, 5, 23, 38, 39, and 52 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Moss.

DISCUSSION

Introduction

Claim 1 involved in the previous appeal recited "selectively electronically linking at least one automated teller machine (ATM) and at least one home banking terminal to the server where a *first user interface* displayed on the ATM and a *second user interface* displayed on the home banking terminal *are substantially the same*" (emphasis added). Claims 6, 30, and 33 also recited first and second "user interfaces." We stated in our decision in Appeal 2002-1880:

Figure 19 discloses a hardware simulation screen to allow an applications programmer to test paths within the applications program (col. 30, lines 36-41). In the upper left portion of Fig. 19 is a simulated keypad and display for an ATM (col. 30, lines 41-42), which represents the "first user interface displayed on the ATM." Since both the home computer terminal and the ATM have a display and a 12-button keypad, it appears that the interfaces are "substantially the same." Although there are differences, such as the "ENTER" key on the ATM, the limitation of "substantially the same" is very broad and does not preclude the existence of some differences. Appellants' home banking terminal interface is illustrated in Figs. 3A-3D, but the claims do not require all of these interfaces. It is sufficient that the interface of Fig. 3B (which is very similar to Fig. 19 of Moss) is "substantially the same" on the home banking terminal and the ATM.

Slip Op. 5. That is, the claims did not require a user interface displayed completely on a screen, so the fact that the user interface on the home terminal comprised a screen and a 12-button hardware keypad on the telephone and the simulated ATM user interface in Figure 19 showed a

display area and a 12-button keypad did not make a difference in the "user interface."

The claims have been amended to recite that the user interfaces are "displayed on a screen." Independent claim 4 has been amended to recite uniform user interfaces on screens. In addition, we now have Appellants' arguments that Figure 19 is merely a simulation of an ATM. These differences must be considered in the rejections.

Findings of fact

Moss and the present application are both assigned to Citicorp Development Center, Inc. Leslie Moss, the first-named inventor on the Moss patent is one of the inventors on the present application. Thus, it is clear that the Moss patent is related to the present subject matter.

Moss, Figure 1, shows a home computer terminal 2 for financial services shaped to resemble a conventional desktop telephone, which corresponds to the "home banking terminal." The terminal user interface has a liquid crystal display 2a and a standard 12-button telephone keypad (col. 4, ll. 7-15; col. 13, ll. 39-43). The display may include the user's last response, the information being sought, and a list of prompts indicating the choices available to the user by pressing a single button in the keypad as well as a series of help prompts (col. 8, ll. 30-39).

The home banking terminal 2 is connected to a session controller 6 in a host computer 8 which serves as a link to informational and financial service computer systems 20a-20d, including Bank A's computer 20a and

Bank B's computer 20b (col. 7, ll. 4-9, 20-33). The network host computer 8 can be provided as part of one of the service computers 20a-20d, "[f]or example, the network host computer 8 might be physically configured as . . . a computer also serving as a bank service computer" (col. 7, ll. 30-32).

The network host provides pages of application software to the user terminal (e.g., col. 8, ll. 8-14). If a user desires to access the service computer 60a of Bank A (Fig. 10 of Moss is similar to Fig. 1 with different numbers), the user presses buttons on the terminal to send a message to the host computer 60, which locates an application program to access the service computer and downloads a program to the terminal (col. 18, ll. 43-54). The terminal asks the user various questions and prompts the user to input the information needed to access his account at the bank, which is transferred to the host computer in a message having a first protocol (col. 18, ll. 54-62). "The network host computer transforms this information into whatever second protocol is conventionally required to communicate with the service computer 60a, for example in the precise manner in which automatic teller machines communicate" (col. 18, ll. 63-67).

Automatic teller machines (ATMs) and home terminals are electronically linked to a host: "The data dictionary includes a specification of the messages used in the applications program. In a preferred embodiment related to banking services, these messages are transaction-oriented, and are the messages which pass to and from the hosts to gather information from and send information to the banking customer at an ATM or telephone computer." Column 29, lines 56-62.

Moss describes an application generation system (AGS) on a development computer 502 which may be used to develop, debug, and test applications programs for a target computer 504 which may be the home services delivery system (Fig. 14; col. 26, l. 26, to col. 28, l. 64). Moss describes that the applications programs in AGS include forms, "such as receipts for automatic teller machines" (col. 29, l. 26), and describes using the AGS for simulation of ATM applications, such as Figure 19 (col. 30, ll. 27-57). Accordingly, AGS is used for development of home banking terminal and ATM applications.

Figure 19 discloses a hardware simulation screen to allow an applications programmer to test paths within the applications program (col. 30, lines 36-41). In the upper left portion of Fig. 19 is a simulated keypad and display for an ATM (col. 30, lines 41-42), which represents the user interface displayed on the ATM.

Anticipation

1.

The first issue is: Does Moss teach an ATM?

Appellants argue that Moss fails to illustrate the presence of a separate ATM and therefore does not teach "selectively electronically linking at least one automated teller machine (ATM) and at least one home banking terminal to the server; and based on the electronic linking, displaying a first user interface on a screen of the ATM" (claim 1), "an automated teller machine (ATM) having a first user interface for display on a screen of the

ATM" (claim 6), "at least one automated teller machine (ATM) having a first user interface" (claim 30), and "at least one automated teller machine (ATM) electronically linked to the server in which the ATM displays on a screen of the ATM a first user interface" (claim 33) (Br. 9-14). It is argued that no ATM is shown in Figure 1 of Moss (*id.* at 10). It is argued that the Moss's statement that "[i]n a preferred embodiment related to banking services, these messages [in application programs] are transaction-oriented, and are the messages which pass to and from the hosts to gather information from and send information to the banking customer at an ATM or telephone computer" (col. 29, ll. 58-62), does not disclose an ATM, "but rather Moss describes a system that can transmit messages to a computer where the messages are similar to the messages that can be transmitted to an ATM" (Br. 10). It is argued that the terminals 2 and 10 in Figure 1 do not perform as an ATM (*id.*). It is argued that "in the absence of an ATM, Moss does not disclose the use of a 'first user interface on the screen on an ATM' as recited in the claims" (*id.* at 12).

It would have been much easier to address the arguments if the Examiner had converted the rejection to an obviousness rejection rather than stick with the anticipation rejection. There can be no serious dispute that it was notoriously well known in the financial industry for ATMs to be connected to bank service computers such as 20a and 20b in Figure 1 and this would have made for a trivial obviousness conclusion on this issue. Nevertheless, we find that an ATM is fairly taught in Moss.

We first note a distinction among the claims. Claim 1 recites "selectively electronically linking at least one automated teller machine (ATM) and at least one home banking terminal to the server" and claim 30 recites that the ATM and the home banking terminal are "electronically linked to the server." Thus, both claims 1 and 30 require the ATM and the home terminal are both connected to the same server. Claim 6 recites "providing an automated teller machine (ATM)" and a "remote terminal" and "establishing an electronic link between the remote terminal and a server; and . . . establishing an electronic link between the server and a business host." Claim 6 does not state that the ATM is connected to a server or host and, therefore, does not require that the ATM and the remote terminal are connected to the same server or host. Claim 33 recites that the ATM is "electronically linked to the server," but says nothing about the home banking terminal being linked to the server. Claims 6 and 33 only require an ATM and a terminal, which can be on different systems. However, Moss teaches an ATM and home terminal on the same host, which meets the ATM limitations of all these independent claims.

The home banking terminal 2 can be connected to the bank service computers 20a, 20b. Bank service computers are conventionally connected to ATMs. Moss teaches that "[i]n a preferred embodiment related to banking services, these messages [in application programs] are transaction-oriented, and are the messages which pass to and from the hosts to gather information from and send information to the banking customer at an ATM or telephone computer" (col. 29, ll. 58-62), which fairly teaches that the

banking computer is handling transactions from both ATMs and home terminals. We disagree with Appellants' argument that this only suggests that ATMs have similar messages because the quote indicates that messages go to both ATMs and home terminals. Moss also teaches that the "network host computer transforms this information [from the home terminal] into whatever second protocol is conventionally required to communicate with the service computer 60a, for example in the precise manner in which automatic teller machines communicate" (col. 18, ll. 63-67), which indicates that both ATMs and home terminals communicate with the host computer. Still further, Moss describes an AGS to develop, debug, and test applications programs for a target computer 504 which may be the home services delivery system (Fig. 14; col. 26, l. 26, to col. 28, l. 64) and for simulation of ATM applications, such as Figure 19 (col. 30, ll. 27-57), which teaches that applications are being sent to both ATMs and home terminals. The fact that Moss does not spend much time talking about ATMs is because the invention is directed to a home services system.

We find that Moss fairly teaches an ATM.

2.

The second issue is: Does Moss teach first and second user interfaces "on a screen" wherein the user interfaces are substantially the same?

Appellants argue that in the absence of an ATM, Moss does not teach a first user interface on a screen on an ATM (Br. 12). Appellants also argue that "[t]he depiction of the hardware of the ATM for the purpose of

illustrating the simulation program is not the same as the graphic interface displayed to a user when an ATM is actually in operation and available to a user" (*id.* at 13).

The Examiner relies on our finding in Appeal 2002-1880 that the first and second user interfaces are "substantially the same."

Moss does not describe that the home terminal user interface and the ATM user interface should be substantially the same. Our finding in Appeal 2002-1880 that the interfaces are substantially the same was based on a 12-button keypad on the telephone resembling the 12-button user interface on the ATM in Figure 19. The claims have been amended to recite that the user interfaces are "displayed on a screen." This abrogates our reasoning because the 12-button keypad is an actual keypad, not one displayed "on a screen." We do not find where the rejection addresses this change in claim language.

In addition, we now have Appellants' arguments that Figure 19 is merely a simulation of an ATM. While Figure 19 shows an ATM interface, we do not know whether the screen is mean to simulate an ATM screen or is meant to simulate hardware at the ATM, such as an actual keyboard, or a combination of both. The claims require the ATM interfaces to be "on a screen," and the buttons are part of the interface, so if the simulation represents a hardware keyboard, the claims will not be met. Since we do not have enough information to decide what the ATM interface is actually like based on the screen simulation, we cannot say without speculating that the

ATM has an interface displayed on a screen. We do not find where the rejection addresses this distinction.

Moss does not clearly teach first and second user interfaces "on a screen" wherein the user interfaces are substantially the same. Accordingly, the anticipation rejection of claims 1, 6-22, 24-30, 33-37, 40-51, and 53-55 is reversed.

Obviousness

The issue, based on Appellants' only argument for claim 4, is: Does Moss teach or suggest a "plurality of remote terminals . . . , the plurality of remote terminals including a first terminal and a second terminal, wherein the second terminal is of a different type than the first terminal"?

The Examiner relies on the telephone-computer 2 (Fig. 1) or 1 (Fig. 10) and the PC terminal 10 (Fig. 1) or 19 (Fig. 10) as different types of terminals (Final Rej. 24).

Appellants argue that Moss describes that "the term 'terminal' shall mean the telephone-computer 1 or a PC terminal 19" (Moss, col. 18, ll. 28-29), which suggests that the terminals are "equivalent" and not different as claimed (Br. 16). Appellants argue, alternatively, that Moss implies that the presence of two distinct terminals is not essential to the operation of the system, so Moss does *not require* the presence of two remote user terminals (*id.*).

Appellants do not attempt to define what is meant a terminal of a "different type." The telephone-computer 1 (Fig. 10) or 2 (Fig. 1) in Moss

"resembles a telephone with a display screen 2a, as described in the Weiss applications" (col. 7, ll. 11-12), and in "the home terminal of Weiss et al, a microcomputer resides within a standard desktop telephone and communicates with the consumer through a liquid crystal display (LCD) and a standard telephone keypad" (col. 4, ll. 11-14). The terminal 2 "functionally mimics an IBM PC/XT microcomputer 10" (col. 7, ll. 17-19). Thus, the terminal is expected to have a "uniform user interface." We find that terminal in a telephone is a "different type" of terminal than a microcomputer because it uses a standard telephone keypad instead of a keyboard, because it uses a small display instead of a conventional computer monitor, and because it is designed for use as telephone, not for general programming functions. No one looking at the two devices would consider them to be the same type of device. The fact that both terminals are capable of carrying out the same functions does not imply that the terminals are the same type. Moss teaches that both types of terminal can be used, so the fact that one may not be used does not teach against both types of terminals.

Moss teaches a "plurality of remote terminals . . . , the plurality of remote terminals including a first terminal and a second terminal, wherein the second terminal is of a different type than the first terminal," as recited in claim 4. The rejection of claim 4 and its dependent claim 5 is affirmed.

The obviousness reasoning over Moss does not cure the deficiencies with respect to independent claims 6 and 33. Accordingly, the rejection of claims 23, 38, 39, and 52 is reversed.

NEW GROUND OF REJECTION UNDER 37 C.F.R. § 41.50(b)

Claim 1 is rejected under 35 U.S.C. § 103(a) as unpatentable over Lawlor, U.S. Patent 5,220,501, issued June 15, 1993. We leave it to the Examiner to consider the patentability of the other claims in view of Lawlor and Lawlor in view of Moss and/or other references.

Claim 1 recites "a first user interface on a screen of an ATM" and "a second user interface on a screen of a home banking terminal, wherein the first user interface and the second user interface are substantially the same." Lawlor teaches a method for providing remote bank services at a terminal connected to a central computer which is connected to a "conventional ATM network" (Abstract). Thus, Lawlor teaches "selectively electronically linking at least one automated teller machine (ATM) and at least one home banking terminal to the server." For example, "[b]ecause the central computer interacts with the user's bank as a standard POS or ATM network node, no significant software changes are required at the banks' computers" (Abstract). Lawlor teaches:

ANSI and others have established standards on ATM digital message protocols and other features of ATMs. A more-or-less standard, generic ATM interface has developed in the banking industry, making it relatively easy for a user to use any ATM on the ATM network once he learned how to interact with this more-or-less standard interface. Of course, ATMs produced by different manufacturers may differ in key placement, number of keys, key legends, screen size, etc. However, there has been a trend toward standardization so as to minimize user discomfort with using a "foreign bank" ATM.

Column 4, lines 24-35. Thus, Lawlor teaches that it was known and an objective in the banking art to standardize ATM interfaces to minimize user discomfort.

Lawlor also teaches:

Moreover, the preferred embodiment terminal and associated user interface to some extent mimics the terminal/interface provided by standard ATMs already in use by millions of bank customers. The preferred embodiment thus eliminates or reduces the level of apprehension may users might harbor toward learning a new terminal and interface. When a typical new user first uses the terminal provided by the present invention, he intuitively knows how to navigate through the user interface/menu structure because the user interface is (at least superficially) similar to that of ATMs he has used in the past.

Column 8, lines 46-57. Thus, Lawlor teaches that the home banking terminal interface should mimic the ATM interface to minimize user discomfort. These are only samples of the teachings in Lawlor. One of ordinary skill in the banking user interface art would have been motivated to make the first user interface of the ATM and the second user interface on a home banking terminal substantially the same in view of Lawlor.

CONCLUSION

The rejection of claims 1, 6-22, 24-30, 33-37, 40-51, and 53-55 under 35 U.S.C. § 102(e) is reversed.

The rejection of claims 4 and 5 under § 103(a) is affirmed.

The rejection of claims 23, 38, 39, and 52 under § 103(a) is reversed.

A new ground of rejection has been entered as to claim 1.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

Regarding any affirmed rejection, 37 C.F.R. § 41.52(a)(1) provides:

(a)(1) Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. . . .

37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the Appellants elect to prosecute further before the Primary Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences

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for final action on the affirmed rejection, including any timely request for rehearing thereof.

Requests for extensions of time are governed by 37 C.F.R. § 1.136(b).
See 37 C.F.R. § 41.50(f).

AFFIRMED-IN-PART - 37 C.F.R. § 41.50(b)

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